

Remarks

Applicant respectfully submits that the Office Action of August 3, 2007 was based on a misreading of Applicant's previously-submitted response, which response included facts that specifically address the alleged deficiencies raised in the instant Office Action.

The Office Action dated August 3, 2007 notes that a declaration filed on January 16, 2007 under 37 CFR 1.131 was deemed insufficient to overcome the Brophy *et al.* reference. The Office Action also lists the following rejections: claims 1-22 stand rejected under 35 U.S.C. § 112(2); claims 1-22 stand rejected under 35 U.S.C. § 102(a) over Brophy *et al.* (U.S. 6,782,412).

Before turning to the merits of the rejections, Applicant notes that the Office Action references a declaration filed under 37 C.F.R. §1.131 on January 16, 2007, yet the declaration to which the Office Action appears to refer was filed on May 24, 2007. The following remarks are based upon an assumption that the Office Action refers to is the declaration filed on May 24, 2007. Applicant requests clarification in the event that any claim rejections are maintained.

The Office Action makes reference to two main issues relating to the aforesaid declaration, the first being an effective date of conception and reduction to practice as supported by the declaration, and the second being an alleged lack of diligence. Beginning with the first issue and the effective date of the declaration, the Office Action has ignored dates in both exhibits filed with the declaration and as supported in the text the declaration, and has instead relied upon a single date in the first exhibit that is not relevant to the reduction to practice. Specifically, the declaration was filed to show a reduction to practice prior to August 24, 1999 and referenced two Exhibits (A and B) as support. Exhibit A includes a document that has a date that is later than the date of the cited Brophy reference (August 24, 1999) and the indicated reduction to practice; however Exhibit A is a later-dated document that describes previous results regarding the claimed invention and its reduction to practice. In this regard, the description in Exhibit A evidences an earlier reduction to practice, regardless of the date of the Exhibit itself. Moreover, Exhibit B includes additional evidence that is also indicated in the declaration as prior to the August 24, 1999 date. The Office Action has not considered Exhibit B in concluding that the declaration is insufficient. In this regard, the Office Action's position that Exhibit A is invalid and that the declaration is insufficient is unfounded and contrary to 37 C.F.R. §1.131.

Turning now to the second issue, Applicant submits that evidence of diligence is not relevant where the invention was reduced to practice prior to the date of the cited reference. This is consistent with the Examiner's discussion of diligence at page 5 of the Office Action. Further regarding proof of reduction to practice as mentioned in the Office Action, in view of the above discussion and the effective date of the declaration and its exhibits as prior to the date of the Brophy reference, reduction to practice (*i.e.*, constructive and actual) is evidenced in advance of the Brophy's effective date. For instance, regarding the independent claims (*i.e.*, claims 1, 15 and 20), page 10 of Exhibit B shows an IntraSwitch PBX (*i.e.*, a control center) that is communicatively coupled to a PC, an IP phone, a video phone, etc. (*i.e.*, a plurality of IP telephony devices). The PC has a display and a user interface that allows a user to configure the IntraSwitch PBX and the other IP telephony devices. Per pages 17 and 18 of Exhibit B, the system provides for user and administration configuration (*i.e.*, control and configuration of the control center and the plurality of IP telephony devices), and further provides various types of user control over telephony communications. Moreover, as discussed at page 14 of Exhibit B, IntraSwitch is implemented using OOP, including Java applets. Per the discussion in both Exhibit A and Exhibit B, this reduction to practice was conceptual and actual, with reference to both testing and implementation (*see, e.g.*, the pages labeled "17" and "18" in Exhibit B, respectively describing lab testing onsite testing). Therefore, reduction to practice prior to August 24, 2007, has been demonstrated by the evidence of record.

In view of the above, the declaration 37 C.F.R. § 1.131 filed on May 24, 2007 is proper and overcomes the Section 102(e) rejection of claims 1-22, and the Brophy reference is not prior art under Section 102(e). Accordingly, Applicant requests that the Section 102(e) rejection of claims 1-22 be withdrawn.

Applicant maintains the traversal of the Section 112(2) rejection of claims 1-22 based upon the use of the term "adapted to" because the Office Action has failed to establish that the term results in claims that are non-limiting in scope. That is, there is no discussion whatsoever as to why the clause "adapted to" is non-limiting in this instance. The Office Action simply recites that the adapted to clauses "are non-limiting in scope" with no explanation as to why they are non-limiting in this instance. The rejection itself states that "[t]he determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case" (citing *In Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329

(Fed. Cir. 2005), yet fails to discuss any facts in the instant case. As Applicant has indicated previously, the term “adapted to” has come to be a commonly used term in claiming an invention and is clear (*i.e.*, to one of skill in the art) as used in the instant application. A brief review of the U.S. Patent Office’s own database indicates that the term “adapted” has been used in the claims of over 100,000 issued patents in recent years. In view of the foregoing, Applicant contends that the scope of the claims is readily ascertainable and therefore the Section 112(2) rejection based upon the term “adapted to” should be withdrawn.

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is encouraged to contact the undersigned at (651) 686-6633.

Respectfully submitted,

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